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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/629,547 04/09/96 TAKAHASHI

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PM82/0903

EXAMINER

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ART UNIT

PAPER NUMBER

3682

DATE MAILED:

09/03/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/629,547

Applicant(s)

Takahashi et al.

Examiner

Vinh Luong

Group Art Unit

3682



☒ Responsive to communication(s) filed on 3/3/99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-12, 16, 28, and 31 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-12 is/are allowed.

☒ Claim(s) 16, 28, and 31 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on 5/23 & 7/23/97 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☒ received in Application No. (Series Code/Serial Number) 07/485,659.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The holding of abandonment on February 25, 1999 is withdrawn and replaced by the following Office action.
2. The Amendment filed on July 1, 1998 (Paper No. 21) has been entered.
3. The Supplemental Amendment after Final filed on November 17, 1998 (Paper No. 25) has not been entered since it does not comply with 37 C.F.R. 1.121(b). Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.121(b).
4. The amendment filed November 17, 1998 proposes amendments to claims 3, 5 and 6 that do not comply with 37 CFR 1.121(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required in response to this Office action.
5. The interlineations or cancellations made in the specification or amendments to the claims could lead to confusion and mistake during the issue and printing processes. Accordingly, the portion of the specification or claims as identified below is required to be rewritten before passing the case to issue. See 37 CFR 1.125 and MPEP § 608.01(q).

All of the pending claims are required to be rewritten.

6. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on May 23, 1997 and July 23, 1997 have been approved by the examiner.
7. The Patent and Trademark Office no longer makes drawing changes. See 1017 O.G. 4. It is applicant's responsibility to ensure that the drawings are corrected. Corrections must be made in accordance with the instructions below.

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The drawing correction must comply with 37 C.F.R. 1.121(b)(3), e.g., any change to the patent drawings (Figs. 1 and 3) must be by way of a new sheet of drawings with the amended figures identified as "amended."

8. Claims 16, 18 and 31 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

Note that a reissue application is not permitted to "recapture" claimed subject matter deliberately canceled in the original application. *In re Clement*, 45 U.S.P.Q. 1161 (CAFC 1997). See M.P.E.P. 1412.02. Note also that in *Hester v. Stein, Inc.*, 46 U.S.P.Q.2d 1641 (CAFC 1998), the Court held that the recapture rule can be triggered by argument alone. Applicant *cannot* acquire, through reissue, claims that are the same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection.

Regarding claim 16 (see Amendment filed on July 1, 1998), note that lines 1-14 of claim 16 are copied from claim 16 of grand parent application Serial No. 07/485,659. However, claim 16 of SN'659 had been rejected by the examiner and affirmed by the Board decision on January 5, 1994. On the other hand, the scope of lines 15 and 16 of claim 16 of this application is narrower in another aspect unrelated to the prior art rejection based on Numata et al. (Japanese Patent Publication No.

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57-058542). Since claim 16 of SN'659 had been canceled in SN'659, applicant cannot recapture it by adding a limitation unrelated to the rejection as set forth above.

Similarly, regarding claim 31 (see Amendment filed on July 1, 1998), note that lines 1-11 of claim 31 are copied from claim 18 of parent application Serial No. 07/485,659. However, claim 18 of SN'659 had been rejected by the examiner and affirmed by the Board decision on January 5, 1994. On the other hand, the scope of lines 12 and 13 of claim 31 of this application is narrower in another aspect unrelated to the prior art rejection based on Numata et al. (Japanese Patent Publication No. 57-058542). Since claim 18 of SN'659 had been canceled in SN'659, applicant cannot recapture it by adding a limitation unrelated to the rejection as set forth above.

Regarding claim 28, note that claim 28 is dependent upon claim 16 which is substantially copied from claim 16 of SN'659. Since claim 16 of SN'659 had been canceled in SN'659, applicant cannot recapture claim 16 of SN'659 by adding a limitation unrelated to the rejection as done in the last two lines of claim 16 of this application.

9. Claims 1-12 are allowed.

10. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

11. Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 305-7687**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and

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delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see M.P.E.P. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-7687) on \_\_\_\_\_

(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 7:30 AM EST to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tamara Graysay, can be reached on (703) 308-2144. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

September 1, 1999



Vinh T. Luong  
Primary Examiner